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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/374,136	08/10/1999	DAVID A. MONROE	58959.0024	3360

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EXAMINER

PATEL, KANJIBHAI B

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 05/09/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/374,136

Applicant(s)
David A. Monroe

Examiner
Kanji Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 7, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-59 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/7/03 has been entered.

Drawings

2. The drawings were objected in the previous office action (Paper No. 6). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 48-55 have been renumbered as 52-59.

Claims 52-59 are pending in the application with the submission filed on 2/7/03.

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Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 52 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,943,140 in view of Nachman (US 5,530,558). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 52 recite substantially very similar limitations as that of claim 1 of U.S. Patent NO. 5,943,140 as shown below.

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For Application claim 52, claim 1 of US Patent No. 5, 943,140 provides a facsimile transmitting/receiving system comprising a standard facsimile machine and a computer based system in communication with said standard facsimile machine column 5, lines 23-25), the system comprising:

an interface positioned intermediately of and in communication with both said facsimile machine and said computer based system (column 5, lines 30-33);

a line for receiving and sending facsimile signals in communication with said interface for selectively communicating directly with said facsimile machine and said computer (column 5, lines 35-40);

means for converting encoded documents to formats compatible with computer supported systems and with said facsimile machine (column 5, lines 41- 44);

wherein said means is further adapted for converting facsimile signals to a format for transmission over distributive communication networks and for converting network transmitted signals in a format for transmission over a facsimile transmission line (column 6, lines 1-5).

U.S. Patent 5,943,140 fails to disclose wherein said interface further comprises one or more switches for selectively controlling electronic communication between (1) said line and said computer based system and (2) said line and said facsimile machine. However, switches are well known and widely used for any application in communication technology. Nachman provides interface circuit for utilizing a facsimile coupled to a PC wherein said interface further comprises one or more switches for selectively controlling electronic communication between (1) said line

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(SW2; figure 1) and said computer (SW2; figure 1) based system and (2) said line and said facsimile machine (SW2; figure 1). Therefore, it would have been obvious to use Nachman's teaching to modify U.S. patent 5,943,140 because it provides a selectively coupling of PC and facsimile machine as shown by Nachman in column 1, lines 45-53.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52-59 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Nachman (US 5,530,558) in view of Scholl et al. (US 5,793,498-- already on record).

For claim 52, Nachman provides a facsimile transmitting/receiving system comprising a standard facsimile machine (30 in figure 2a) and a computer (40 in figure 2a) based system in communication with said standard facsimile machine, the system comprising:

an interface (10 in figure 2a) positioned intermediately of and in communication with both said facsimile machine (30) and said computer (40) based system;

a line (RJ 11 tel Cable in figure 2a provides a telephone line) for receiving and sending facsimile signals in communication with said interface for selectively communicating directly with said facsimile machine and said computer;

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means for converting encoded documents to formats compatible with computer supported systems and with said facsimile machine (column 5, lines 17-20);

wherein said interface further comprises one or more switches (SW1-4 in figure 1 provide more switches) for selectively controlling electronic communication between (1) said line (SW2) and said computer (SW2) based system and (2) said line and said facsimile machine (SW2).

Nachman differs from claim 52 in which he does not explicitly provide that the means is further adapted for converting facsimile signals to a format for transmission over distributive communication networks and for converting network transmitted signals in a format for transmission over a facsimile transmission line. Scholl et al. provide means is further adapted for converting facsimile signals to a format for transmission over distributive communication networks (column 3, line 45 to column 4 line 19; figure 8) and for converting network transmitted signals in a format for transmission over a facsimile transmission line. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nachman wherein the means is further adapted for converting facsimile signals to a format for transmission over distributive communication networks and for converting network transmitted signals in a format for transmission over a facsimile transmission line. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Nachman by the teaching of Scholl et al. in order to provide system for processing, sending, and receiving facsimile data transmissions without using dedicated G3 hardware as shown by Scholl et al. in column 2, lines 44-49.

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For claim 53, Nachman discloses the facsimile system of claim 52, wherein said interface further comprises a first switch (SW2 in figure 1) operable between an open position and a closed position, wherein said first switch in said closed position allows direct communication between said line and said computer based system (column 2, line 58 to column 3 line 10).

For claim 54, Nachman discloses the facsimile system of claim 53, wherein said first switch in said open position prevents communication between said line and said computer based system (SW2 in figure 1; column 2, line 58 to column 3 line 10).

For claim 55, Nachman discloses the facsimile system of claim 53, wherein said interface further comprises a second switch operable between an open position and a closed position, wherein said second switch in said closed position allows direct communication between said line and said facsimile machine (column 4, lines 27-40).

For claim 56, Nachman discloses the facsimile system of claim 55, wherein said second switch in said open position prevents communication between said line and said computer based system (SW2 in figure 1; column 2, line 58 to column 3 line 10).

For claim 57, Nachman discloses the facsimile system of claim 55, wherein said line is in direct communication with both (1) said computer based system and (2) said facsimile machine when said first switch and said second switch are simultaneously in their respective closed positions (column 3, lines 15-26).

For claim 58, Nachman discloses the facsimile system of claim 52, further comprising a ring generator (14 in figure 1) for initiating said facsimile machine.

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For claim 59, Nachman discloses the facsimile system of claim 58, further comprising a parallel switch (SW 1) for selectively activating said ring generator (14 in figure 1).

Other prior art cited

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cann (US 5,440,619) discloses a voice, data and facsimile modem with modified ring back answering.

Hamada et al. (US 5,751,442) discloses a communication connection apparatus for use in direct connection between facsimile modem apparatus and facsimile apparatus.

Mankovitz (US 5,577,108) discloses an information distribution system with self-contained programmable automatic interface unit.

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Contact information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kanji Patel** whose telephone number is (703) 305-4011. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 6:30 p.m. Friday off.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, **Mehta, Bhavesh**, can be reached on (703) 308-5246.

Any inquiry of general nature or relating to the status of this application should be directed to the **Group receptionist** whose telephone number is (703) 305-4700.

The **Fax number** for this group is (703) 306-5487.



Kanji Patel
Patent Examiner
Group Art Unit 2625
May 4, 2003